

# MORRISON & FOERSTER LLP

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**FAXED**  
11:28 AM

**To: Examiner Mau Tran**

USPTO

**Facsimile:** (703) 308-4556 or  
(703) 305-1935  
**Telephone:** (703) 605-1165

**Fr m:** Kawai Lau, Ph.D.

**Date:** ~~March 9, 2001~~  
March 13, 2001

**INVENTOR:** Patrick Mark CURRY, et al.

**SERIAL NO.:** 09/556,833

**Filed:** April 21, 2000

**TITLE:** Immunoadjuvant PDT Treatment of Metastatic Tumors

**FAX RECEIVED**  
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## Comments:

Applicants thank Examiner Tran for the courtesy of a telephone call concerning the instant application.

Accompanying this sheet are copies of the response filed February 22, 2001.

The response included 1) a transmittal form; 2) a fee transmittal form; 3) a response to Restriction Requirement; 4) a Petition for extension of time; 5) a change of address request; 6) a check for \$195.00; and 7) a return postcard.

Applicants respectfully request that these copies be entered in lieu of the original which is apparently missing.

Client # 27301-20111.00

sd-31936

**OFFICIAL**

PTO/SB/21 (08-00)

Please type a plus sign (+) inside this box → ☒Approved for use through 10/31/02. OMB 0851-0031  
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**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number Of Pages In This Submission

Application Number 09/556,833

Filing Date April 21, 2000

First Named Inventor Patrick Mark CURRY et al.

Group Art Unit 1642

Examiner Name M. Tran

Attorney Docket No. 273012011100

**ENCLOSURES (check all that apply)**☒ Fee Transmittal Form☒ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declarations☒ Extension of Time Request (2 mo)☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/  
Incomplete Application☐ Response to Missing Parts  
under 37 CFR 1.52 or 1.53☐ Assignment Papers  
(for an Application)☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a  
Provisional Application☐ Power of Attorney, Revocation  
Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) \_\_\_\_\_☐ After Allowance Communication to  
Group☐ Appeal Communication to Board of  
Appeals and Interferences☐ Appeal Communication to Group  
(Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please identify  
below): Response to Restriction  
Requirement; Change of Address; Return  
Postcard

Remarks

**SIGNATURE OF APPLICANT, ATTORNEY OR AGENT**

Firm

Kawai Lau

or

Individual Name

Morrison &amp; Foerster LLP

Signature

Date

February 22, 2001

**CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"**

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Melanie Carmosino

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sd-29969

PTO/SB/17 (09-00)

Approved for use through 10/31/2002. OMB 0851-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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**FEE TRANSMITTAL  
FOR FY 2001**

Patent fees are subject to annual revision.

**Complete if Known**

Application Number	09/556,833
Filing Date	April 21, 2000
First Named Inventor	Patrick Mark CURRY et al.
Examiner Name	M. Tran
Group Art Unit	1642
Attorney Docket No.	273012011100

**TOTAL AMOUNT OF PAYMENT****(\$)** 195.00**METHOD OF PAYMENT**

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number **03-1952**Deposit Account Name **Morrison & Foerster LLP**

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- Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

- ☒
- Applicant claims small entity status. See 37 CFR 1.27

- 2.
- ☒
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- Other

**FEE CALCULATION****1. BASIC FILING FEE**

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	

**SUBTOTAL (1)** **(\$)****2. EXTRA CLAIM FEES**

Total Claims	- 20** =	Extra Claims	Fee from below	Fee Paid
Independent Claims	- 3** =			
Multiple Dependent				

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	10	203	0	Claims in excess of 20
102	60	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claims, if not paid
106	60	206	40	**Release independent claims over original patent
110	18	210	0	**Release claims in excess of 20 and over original patent

**SUBTOTAL (2)** **(\$)\*\***

\*\* or number previously paid, if greater; For reissues, see above.

**FEE CALCULATION (continued)**

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	195.00
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,240	241	620	Petition to revive - unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petitions of the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Sheet	
581	40	581	40	Recording each patent assignment per properties (times number of properties)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

**SUBTOTAL (3)** **(\$)** 195.00**SUBMITTED BY****Complete (if applicable)**

Name (Print/Type)	Kawal Lau	Registration No. (Attorney/Agent)	44,461	Telephone	858-720-5178
Signature		Date	February 22, 2001		

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sd-29968

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Patent #5,636,874

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WASHINGTON, DC 20231

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Docket No.: 273012011100

Atty: KXL/amf,

Serial No.: 09/556,833

Filing Date: April 21, 2000

Title: IMMUNOADJUVANT PDT TREATMENT OF METASTATIC TUMORS

Date of Mailing: February 22, 2001 via First Class Mail

Papers enclosed herewith:

1. Transmittal, 1 page
2. Fee Transmittal, 1 page (in duplicate)
3. Response to Restriction Requirement, 3 pages
4. Petition for two-month Extension of Time - 1 page
5. Change of Address, 2 pages
6. Check in the amount of \$195.00
7. Return Postcard

\*\* TOTAL PAGE.10 \*\*

03/13/01 TUE 12:19 [TX/RX NO 8184] 010

PATENT  
Docket No. 273012001110

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Melanie Carmosino

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In the application of:

Patrick Mark CURRY et al.

Serial No.: 09/556,833

Filing Date: April 21, 2000

For: IMMUNOADJUVANT PDT  
TREATMENT OF METASTATIC  
TUMORS

Examiner: Tran, M.

Group Art Unit: 1642

**RESPONSE TO RESTRICTION REQUIREMENT**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

This is in response to the Office Action mailed November 22, 2000, time for response to which was initially set to expire December 22, 2000. Accordingly, a Petition for a two month extension of time is included herewith, extending the time for response to February 22, 2001.

Applicants respectfully traverse the Restriction and submit that the asserted basis for the Restriction are insufficient. Applicants thus request the Restriction be reviewed and modified for the following reasons.

sd-30023

The Examiner has stated that Group I (claims 1, 3, 5-9, and 11-16) and Group II (claims 2, 4, 5-7 and 10-15) are "different inventions" having "different functions with different modes of operation and different effects." Applicants respectfully traverse based on the following.

As an initial matter, Applicants note that both Groups have been classified by the Examiner as belonging to class 424, subclass 184.1. Thus regardless of the correctness of the above position, Applicants respectfully point out that there is no search burden present because the search of Group I would be identical to the search of Group II and vice versa. Because no burden of search is present in searching a single subclass (in contrast to the requirement for a "serious burden" at MPEP 803), the reasons for restriction between these Groups are insufficient and the restriction may be properly withdrawn.

Moreover, the only rationale presented in support of the above assertion is that the claims of Group I are directed to methods of treating cancer "which is limited to percentage of patients that can be treated" while the claims of Group II are directed to methods of preventing cancer "which concern different groups of patients not encompassed by Group I." Applicants respectfully submit that this rationale simply does not fit the facts of the claims as presented.

First, the above rationale appears incorrect in asserting that the claims of Group I do not "encompass" the claims of Group II. It is entirely possible that a subject undergoing treatment for existing metastatic tumors (Group I) may also be treated to prevent the development of additional metastatic tumors (Group II). Applicants thus respectfully submit that the above rationale fails to support the Restriction Requirement.

Moreover, the claims of Groups I and II are identically directed to methods comprising one step of administering and a second step of irradiating, with the administered materials being identical in both Groups and the irradiation being with identical light in both Groups. Thus Applicants respectfully submit that the methods cannot be viewed as directed to "different methods."

Applicants note that the language used in the above rationale suggests that the preamble of claims 1 and 3 versus 2 may have been relied upon as the basis for the Restriction Requirement. If so, the Examiner is respectfully requested to make this clear on the record that the preamble of the claims have been accorded sufficient patentable weight to warrant the Restriction Requirement. Applicants note, however, that if this is in fact the Examiner's position, the simple deletion of the preamble would obviate the basis for Restriction.

In the event that the instant Restriction Requirement is maintained despite the above discussion, Applicants hereby elect Group I, claims 1, 3, 5-9, and 11-16, with traverse for the reasons presented above.

Applicants expressly reserve the right under 35 U.S.C. § 121 to file a divisional application directed to the nonelected subject matter during the pendency of this application, or an application claiming priority from this application.

Applicant requests examination of the elected subject matter on the merits.

In the event that the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 273012011100. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

Dated: February 22, 2001

By:

  
Kawai Lau  
Registration No. 44,461

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Serial No. 09/556,833  
Docket No. 273012011100

sd-30023